

DISCUSSION OF THE CLAIMS

Claims 14-27 and 30-38 are active in the present application. Claims 1-13 and 28-29 are canceled claims. Claims 14-24 and 36-37 are presently withdrawn from active prosecution. Independent Claim 25 is amended herein to recite a nanostructured particle having an average diameter of from 30 to 100 μm . Support for the amendment is found in previously presented Claims 28 and 29. Claim 29 is a canceled claim.

The specification has been amended for matters of form.

No new matter is added.

REMARKS

The Office asserted that previously pending Claim 25 is obvious over Sekutowski's (U.S. 6,156,327) description of Example 5. Applicants submit that Sekutowski fails to disclose or suggest an aqueous suspension that comprises a nanostructured particle having an average diameter of 30-100 μm as presently claimed. In fact, Sekutowski discloses compositions that include particular materials that "have a median individual particle size below about 10 μm ..." (see column 4, lines 1-5 of Sekutowski).

Applicants submit that present Claim 25 is not obvious in view of Sekutowski and respectfully request withdrawal of the rejection.

The Office previously rejected Claim 25 for failing to comply with the written description requirement. The Office asserts that the limitation that the nanostructured particle is present in an amount of 0.01-1% by weight is not supported by the original specification. The Office appears to take the position that the disclosure of a composition that contains 1% by weight of nanoparticles in the example of the present specifications is insufficient to support the recitation of a 1% by weight upper limit in the range recited in present Claim 1.

The Office errs as a matter of law. Applicants draw the Office's attention to MPEP § 2163.04(III) which relates to the written description requirement for amended claims reciting ranges. This section of the MPEP cites to *In re Wertheim* to explain that where a broad range is supported by the original specification and the specification discloses specific examples within the broader range, an amendment to the claim to narrow the initially recited range using the disclosure of the examples to define upper or lower thresholds meets the written description requirement.

The facts in *Wertheim* are similar here. Applicants disclosed an invention that includes a composition containing nanostructured particles in a broad range of concentration.

Applicants disclosed an example in which the nanostructured particle is present in an amount of 1% by weight.

Those of ordinary skill in the art readily recognize that Applicants' disclosure of a broad range included and encompassed any sub-range in the broad range. The Example of the specification provides explicit support for an upper threshold for the amount of nanostructured particles of 1% by weight. Applicants thus submit that the presently claimed invention was described in the original specification and respectfully request withdrawal of the rejection.

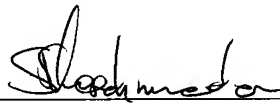
For the reasons discussed above in detail, Applicants submit that the rejections should be withdrawn.

REQUEST FOR REJOINDER

Claims 14-24 and 36-37 are presently withdrawn from prosecution. Applicants submit that upon determining that the subject matter of present Claim 25 is allowable, rejoinder and allowance of dependent Claims 14-24 and 36-37 is appropriate in view of the fact that each of the presently withdrawn claims directly or indirectly depends from Claim 25.

Respectfully submitted,

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